


- 
19. A composition according to claim 9 wherein said foaming agent is lauryl betaine.
20. A composition according to claim 10 wherein said surface active agent is present in a concentration of from about 15 to about 25%.
-

REMARKS

This Amendment is respectfully submitted in response to the Office Action rendered October 19, 2000. It is timely in view of the Petition for extension of Time and fee submitted concurrently herewith. An appendix of amended claims is respectfully also submitted concurrently herewith.

The claims have been amended in order to more clearly describe the compositions and methods of applicants' invention and to conform with the formal requirements of 35 U.S.C. Claims 18-20 have been added and find basis in the Specification in original claims 4, 9 and 10.

The Office Action of October 19, 2000 objected to the declaration and oath under 37 CFR 1.67(a) in that it was defective. A new declaration is being sought from the inventors, who are overseas, and will be submitted as soon as possible.

Claim 4 was rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Applicants respectfully suggest that the term "glacier SC 809 A" is accessible and known to those of ordinary skill in the art, and currently are seeking reference from the inventors who, being overseas, have been difficult to obtain information from. As soon as this information is available, applicants will supply it to the Patent and Trademark Office.

Claims 15-17 were rejected under 35 U.S.C. 101 because the claimed invention was directed to "non-statutory subject matter" in that they referred to a "use". Claims 15-17 as amended refer to a "method" of using the compositions of the invention. Basis for the amendments may be found in the specification, *inter alia*, at page 7, lines 5-9. Applicants respectfully request reconsideration of this rejection light of the foregoing amendments to the claims and discussion.

Claims 5, 7-15 were objected to under 35 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only and cannot depend from other multiple dependent claim. Applicants respectfully request reconsideration of this rejection in light of the foregoing amendments to the claims. The claims have been amended in order to eliminate multiple dependencies. Applicants respectfully submit that the foregoing amendments render this rejection moot.

The compositions of applicant's invention provide a "freshening" product which refreshes the individual using it without irritating the skin of the user. Applicants were able to achieve this result with a freshening cosmetic composition containing particular ratios of menthol and menthyl lactate in order to provide a barely perceptible odor without irritating the skin of the user.

Claims 1-3 were rejected under 35 U.S.C. 103(a) as being unpatentable over applicants in view of Koga JP 10,231,238. The rejection argues that applicants admit that menthyl lactate and menthol are used

in cosmetic and pharmaceutical compositions, that menthol concentrations in compositions at the level 1.25% to 16% impart strong flavor and that menthol possesses freshening and anti-irritant properties at pages 1-3 of the disclosure [Office Action, p. 4]. The Office Action states that Koga "teaches a cosmetic composition that is prepared by adding 0.001-10.0 weight percent of menthol and at least one of menthyl lactate, menthyl glycoside menthyl hydroxybutyrate, menthoxypropanediol and menthoxyfurane [Office Action, p. 4]. Applicants respectfully request reconsideration of this rejection in light of the ensuing discussion.

Koga relates to a "cosmetic material in which one or two or more substances selected from refrigerants, ethanol and isopropyl alcohol are compounded" [Koga, p. 1]. Koga further mentions the use of a combination of "quick acting refrigerants", such as menthol and the use of "delayed action refrigerants", such as menthyl lactate [Koga, p. 2, para. 0005].

Although Koga mentions a combination of menthol and menthyl lactate, applicants respectfully submit that Koga does not teach or suggest the compositions or methods of their invention. Nowhere does Koga recognize the problem of irritation caused by cooling agents nor does it suggest or teach the unexpected achievement of applicants' invention: obtaining cooling of the skin without concomitant irritation. Koga's examples all contain menthol in greater concentration than menthyl lactate, when they appear in the same compositions together. In contrast, Applicants' compositions contain menthol and menthyl lactate in the ratio of from about 1:3 to about 1:10 and attain the result of providing a freshening composition that does not irritate the skin. As set forth in Example 2 of the Specification, compositions containing menthol and menthyl lactate in a ratio of about 1:5, were better for obtaining a cooling effect. Further, as set forth in Example 4, such compositions were only moderately to slightly irritating. In contrast, the compositions set forth in Koga equal or greater amounts of menthol as compared with menthyl lactate.

The Office October 19, 2000 suggests that "the state of the art is such that one of ordinary skill...would know the routine procedure for testing different concentrations ratios of menthol and menthyl lactate...to provide a composition that is not irritating to the human body." [Office Action, p. 4]. Applicants respectfully submit that the standard for determining obviousness is not knowing the "routine procedure for testing" or the determination that an experiment is "obvious to try". Rather, it is whether the claimed invention is disclosed or suggestion by the prior art as a whole. Nothing in Koga suggests or discloses that the specific ratios of menthol to menthyl lactate claimed in the above-identified patent application would achieve the unexpected result of a composition that is both freshening and non-irritating. Applicants respectfully request reconsideration of the foregoing rejection over Koga in view of the foregoing amendments to the claims and discussion.

Claims 1-13 were also rejected under 35 U.S.C. 103(a) as being unpatentable in view of Fowler et al. The Office Action of October 19, 2000 claims that Fowler et al. discloses a cleansing composition containing, *inter alia*, menthol and menthyl lactate. The Office Action suggests that one of ordinary skill in the art would know a routine procedure for testing different concentrations of menthol in combination with

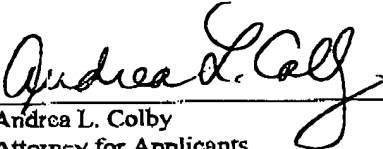
different concentrations of menthyl lactate to provide a composition that is not irritating. [Office Action, p. 5]. Applicants respectfully request reconsideration of this rejection in view of the ensuing discussion.

Fowler et al. relates to a personal care composition containing insoluble micronized cleansing particles, a water soluble or dispersible gelling agent and water [Fowler et al., col. 2, l. 27-37]. Applicants respectfully submit that Fowler et al. mentions literally dozens of compounds that may be present in the described compositions. Nowhere does Fowler et al. recognize or propose solutions to the problem of irritation and the balance between the desirable properties of freshening cleansing compositions.

Again, applicants respectfully submit that it is the ratio, not the concentration, of menthol and menthyl lactate present in the composition that produces the unexpected results of cooling effect without irritation to the skin. Fowler et al. does not teach or suggest such a solution to this problem. Applicants therefore respectfully request reconsideration of this rejection of the claims under 35 U.S.C. 103(a).

Applicants respectfully request reconsideration of the rejections and objections set forth in the Office Action of September 19, 2000 in view of the foregoing amendments to the claims and discussion. An early allowance is earnestly solicited.

Respectfully submitted,


Andrea L. Colby
Attorney for Applicants
Reg. No. 30,194

Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, New Jersey 08933-7003
(732) 524-2792
April 19, 2001